



Docket No.: 260364US40PCT

COMMISSIONER FOR PATENTS
ALEXANDRIA, VIRGINIA 22313



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RE: Application Serial No.: 10/511,441
Applicants: Tomoji MARUYAMA, et al.
Filing Date: May 3, 2005
For: ORGANISM TISSUE SUTURING APPARATUS
Group Art Unit: 3734
Examiner: YABUT, DIANE D

SIR:

Attached hereto for filing are the following papers:

Provisional Election

Our check in the amount of \$0.00 is attached covering any required fees. In the event any variance exists between the amount enclosed and the Patent Office charges for filing the above-noted documents, including any fees required under 37 C.F.R. 1.136 for any necessary Extension of Time to make the filing of the attached documents timely, please charge or credit the difference to our Deposit Account No. 15-0030. Further, if these papers are not considered timely filed, then a petition is hereby made under 37 C.F.R. 1.136 for the necessary extension of time. A duplicate copy of this sheet is enclosed.

Respectfully submitted,

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IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF :
TOMOJI MARUYAMA, ET AL. : EXAMINER: YABUT, DIANE D
SERIAL NO: 10/511,441 :
FILED: MAY 3, 2005 : GROUP ART UNIT: 3734
FOR: ORGANISM TISSUE SUTURING :
APPARATUS

PROVISIONAL ELECTION

COMMISSIONER FOR PATENTS
ALEXANDRIA, VIRGINIA 22313

SIR:

In response to the Election of Species Requirement stated in the Official Action dated October 19, 2006, Applicants provisionally elect Species I, as shown in Figures 1-17, and identify Claims 1-8 as readable on the elected species.

Applicants respectfully traverse the outstanding election requirement for following reasons.

First, the outstanding Office Action simply provides a conclusory statement that “[t]his application contains claims directed to the following patentably distinct species of the claimed invention.” and does not present any particular reasons for such a holding.

However, MPEP §808.01 states the following:

The particular reasons relied on by the examiner for holding that the inventions as claimed are either independent or distinct should be concisely stated. A mere statement of conclusion is inadequate. The reasons upon which the conclusion is based should be given.

Hence, Applicants respectfully submit that in the absence of any annunciated basis, the PTO has not carried its burden of proof stated in MPEP §808.01.

Further, MPEP §806.04(f) states:

Where two or more species are claimed, a requirement for restriction to a single species may be proper if the species are mutually exclusive.

The outstanding Election requirement omits any statement or basis for finding the Claims “mutually exclusive.” Therefore, the PTO has not carried the burden implied by MPEP §806.04(f), and on that basis, Applicants traverse the Election requirement.

Furthermore, MPEP §803 states the following:

If the search and examination of all the claims in an application can be made without serious burden, the examiner must examine them on the merits, even though they include claims to independent or distinct inventions.

Claims 1-24 are all directed to organism tissue suturing apparatus, and Claim 1 is acknowledged as generic. Thus, it appears that the claims in the present application are part of an overlapping search area and that a search for Claims 1-8 would necessarily include a search directed to the rest of the claims as well. It is therefore believed that there is no undue burden on the Examiner to search all the claims under MPEP § 803, and Applicants respectfully traverse the Election of Species Requirement on the grounds that a search and examination of the entire application would not place a *serious* burden on the Examiner.

Accordingly, it is respectfully requested that the requirement to elect a single disclosed species be withdrawn, and that a full examination on the merits of each of Claims 1-24 be conducted.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
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